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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,196	10/10/2001	Doyle E. Bennett	4023/P1/480001	9636
26185 7590 01/29/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER ELEY, TIMOTHY V	
			ART UNIT 3724	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/975,196

Applicant(s)

BENNETT ET AL.

Examiner

Timothy V. Eley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-24 and 29-41 is/are pending in the application.
- 4a) Of the above claim(s) 23,31-33,35-39 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,11,13-22,24,29,30,34 and 40 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1,2,11,13-17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kubo et al(5,645,474), as applied in the rejected filed July 10, 2006.

- In addition, the damping material does not rebound to its original shape after being deformed, as broadly recited by applicant. As recited by applicant, the damping material can be deformed by cracking or breaking, and therefore not capable of rebounding to its original shape.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 4-6,18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo et al in view of Wang et al(6,273,803), as applied in the rejection filed July 10, 2006.

5. Claims 21,29,34, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katzke(3,747,282), as applied in the rejection filed July 10, 2006.

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6. Claims 22,24, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katzke in view of Yamamoto et al(5,740,893), as applied in the rejection filed July 10, 2006.

Response to Arguments

7. Applicant's arguments filed November 3, 2006 have been fully considered but they are not persuasive.

- Applicant argues that claim 1 calls for a "damping material" that will "reduce the translation of vibrational energy between the retainer and the base", and there is no suggestion in Kubo that the insert ring 6 will reduce the translation of vibrational energy between the retainer and the base, and Kubo teaches the insert ring being formed from a rigid material; a rigid material would tend to translate vibrations, rather than dampen them.
 - However, the insert ring 6 is manufactured from epoxy resin, polyesters and polyimides both filled with glass fiber. At least epoxy resin and glass fiber are both well known vibration dampening materials. See Dublin, Jr.(6,068,394) at column 7, lines 32-35; Uchida et al(5,061,778) at column 2, line 18; Yamamoto et al(5,004,764) at column 1, lines 39-43; Hou et al (2004/0013819 A1) at paragraph 0092, lines 5-7; Bohn et al (5,916,954) at column 4, lines 9-20.
- Applicant argues that the backup ring 5 is not the damping material required by claim 1.

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- o The examiner did not state that the backup ring 5 was the damping material.
- Applicant argues the rejection of claim 21 over Kubo.
 - o This rejection is no longer being applied due to applicant's amendment to claim 21.
- Applicant argues that there is no motivation expressed in Katz(k)e to modify Katz(k)e to provide a retainer formed from one of the materials recited in claims 21 and 29, and the Examiner has impermissibly used hindsight in an attempt to reconstruct the applicant's invention.
 - o Applicant's accusation of impermissible hindsight is totally incorrect. Polytetrafluoroethylene is stated in applicant's specification(page 3, lines 5-13) as being part of the preferred group of materials used for making the retaining ring. Also, in the amendment filed September 30, 2005, applicant amended claims 21 and 29 by deleting polytetrafluoroethylene therefrom. Further, there is no mention whatsoever anywhere in the specification that one particular material has any advantage over another. Furthermore, clearly any material that exhibits similar characteristics to polytetrafluoroethylene may be used.

Allowable Subject Matter

8. Claims 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form

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including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- The cited prior art discloses damping materials.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

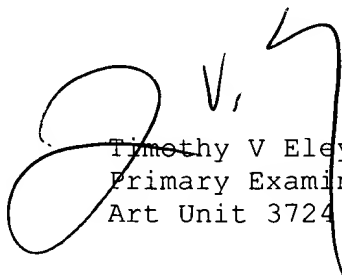
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy V. Eley whose telephone number is 571-272-4506. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-

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4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Timothy V Eley
Primary Examiner
Art Unit 3724

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